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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,852	10/22/2001	Daniel V. East	36488-167637	7743
26694	7590	12/02/2005		
VENABLE LLP			EXAMINER	
P.O. BOX 34385			SHERR, CRISTINA O	
WASHINGTON, DC 20045-9998			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/982,852	EAST ET AL.	
Examiner	Art Unit		
Cristina Owen Sherr	3621		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 July 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-24 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date . . . .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: . . . .

## DETAILED ACTION

1. This communication is in response to applicant's amendment filed July 27, 2005. Claims 1-24 are pending in this case.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The term "in the event of inaccessibility" in claims 1, 16 and 24 is an indefinite term that renders the claim indefinite. The term "inaccessibility" is not defined by the claim, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, does the claim refer to physical inaccessibility, such as a barricaded or locked door, or to power outages making all computers in the building inoperable, etc? Does it refer to mere network outages? In short, the independent claims do not properly define the metes and bounds of the invention.
6. For these reasons, independent claims 1, 16 and 24 and their dependent claims 2-15 and 17-23 are rejected under 35 U.S.C. 112.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christiano (US 5,671,412).

5. Regarding claim 1 -

Christiano discloses a method for providing access to application software in the event of inaccessibility of a license management system (e.g. col 3 ln 67 – col 4 ln4), comprising the steps of determining whether a user has a valid software license to run a software application including sending a query to the license management system (e.g. col 4 ln 44-46); and permitting a recognized user to execute said software application in the event of inaccessibility of the license management system (e.g. col 17 ln 15-20, col 3 ln 67-col 4 ln 4).

6. Christiano does not specify exactly the same license descriptions and terms as in the instant claims, however, it would be obvious to one of ordinary skill in the art to adapt the teachings of Christiano in order to obtain the instant claims, thereby maximizing efficiency and accessibility in the use of mission-critical software.

7. Regarding claim 2 -

Christiano discloses the method according to claim 1, wherein said permitting step comprises: recognizing said user as a previously valid user, before permitting said recognized user to execute said software application (e.g. col 17 ln 20-22). As above, Christiano does not specify exactly the same license descriptions and terms as in the instant claims, however, it would be obvious to one of ordinary skill in the art to adapt the teachings of Christiano in order to obtain the instant claims, thereby obtaining greater efficiency for the use of mission-critical software.

8. Regarding claim 3 -

Christiano discloses the method according to claim 2, wherein said recognizing step comprises: determining if access to said software application by said user has previously been validly authorized via said license management system (e.g. col 19 ln 11-15). Note that it stands to reason, if the user has not been previously validly authorized, there will be no license record.

9. Regarding claim 4 -

Christiano discloses the method according to claim 2, further comprising: executing said software application in a punishment mode comprising: imposing a punishment (e.g. col 22, ln 5-20). Although Christiano does not use the term "punishment" the cited lines refer to ways in which the software behaves differently while operating under the failsafe mode. Even if not termed "punishment" by Christiano, having a "failsafe" or "overdraft" message flashing constantly on the screen is arguably annoying enough to be considered a punishment or penalty. Nothing in claim 4 is more specific as to the punishment.

10. Regarding claim 7 -

Christiano discloses the method according to claim 4, wherein said punishment comprises: increasing said punishment upon occurrence of a first criterion (e.g. col 22 ln 5-20). Although Christiano does not specify increasing a punishment it does discuss different ways to indicate failsafe and/or overdraft status. It would be obvious to one of ordinary skill in the art to include an increase in such ways to indicate failsafe or overdraft status as one more different way of indicating said status.

11. Regarding claim 8 -

Christiano discloses the method according to claim 4, wherein said punishment comprises: decreasing said punishment upon occurrence of a second criterion (e.g. col 22 ln 5-20). Failsafe and overdraft are different criteria, and, as above, under claim 7, a decrease in such ways to indicate failsafe or overdraft status would be one more different way of indicating said status.

12. Regarding claim 9 -

Christiano discloses the method according to claim 1, further comprising: storing recognition of previously authorized access on a local workstation used by said recognized user (e.g. col 21 ln 59-61).

13. Regarding claim 10 -

Christiano discloses the method according to claim 9, wherein said recognition is stored as an encrypted code key in a register of said local workstation (e.g. col 11 ln 42-57 Table 1).

14. Regarding claim 11 -

Christiano discloses the method according to claim 4, wherein said punishment mode comprises: increasing said punishment if said recognized user subsequently attempts to execute said application in failsafe mode in the event of inaccessibility of the license management system (e.g. col 22 ln 5-20). Although Christiano does not specify increasing a punishment it does discuss different ways to indicate failsafe and/or overdraft status. It would be obvious to one of ordinary skill in the art to include an increase in such ways to indicate failsafe or overdraft status as one more different way of indicating said status.

15. Regarding claim 12 -

Christiano discloses the method according to claim 4, wherein said punishment mode comprises: decreasing punishment if said recognized user subsequently attempts to execute said application including validated authorization by the license management system (e.g. col 22 ln 5-20). Failsafe and overdraft are different criteria, and, as above, under claim 7, a decrease in such ways to indicate failsafe or overdraft status would be one more different way of indicating said status.

16. Regarding claim 13 -

Christiano discloses the method according to claim 4, wherein said punishment mode comprises: imposing at least one of a time delay, a time limit, a software impediment, and a disablement of functionality of said software application program (e.g. col 22 ln 5-20). As above, Christiano does not use the term punishment, however, he does describe messages being displayed when software is in use under failsafe status, which can be considered a software impediment.

17. Regarding claim 14 -

Christiano discloses the method according to claim 1, wherein said license management system is a license server (e.g. fig. 1).

18. Regarding claim 15 -

Christiano discloses the method according to claim 1, wherein said permitting step comprises determining whether any previously valid authorizations have been established with said license management system by checking a value set when said software application is initially validly installed (e.g. col 21 ln51-57).

19. Regarding claim 16 -

Christiano discloses a system for managing access to concurrent software licenses, comprising: a network (e.g. col 3 ln 18) a license management system coupled to said network operative to authorize a user of a software application (e.g. col 3 ln 20-25) and a client workstation coupled to said network, wherein said client workstation comprises a validation device operative to permit a recognized user to execute said software application in the event of inaccessibility of a license management system (e.g. col 3 ln 67 – col 4 ln 4).

20. As above, Christiano does not specify exactly the same license descriptions and terms as in the instant claims, however, it would be obvious to one of ordinary skill in the art to adapt the teachings of Christiano in order to obtain the instant claims, thereby maximizing efficiency and accessibility in the use of mission-critical software.

21. Regarding claim 17 -

Christiano discloses the system according to claim 16, wherein said validation device is operative to recognize whether said user previously obtained a valid authorization to execute said software application by said license management system before permitting execution of said software application (e.g. col 17 ln 20-22). As above, Christiano does not specify exactly the same license descriptions and terms as in the instant claims, however, it would be obvious to one of ordinary skill in the art to adapt the teachings of Christiano in order to obtain the instant claims, thereby obtaining greater efficiency for the use of mission-critical software.

22. Regarding claim 18 -

Christiano discloses the system according to claim 16, wherein said validation device permits said user to run said software application with a punishment (e.g. col 22, ln 5-20). Although Christiano does not use the term "punishment" the cited lines refer to ways in which the software behaves differently while operating under the failsafe mode. Even if not termed "punishment" by Christiano, having a "failsafe" or "overdraft" message flashing constantly on the screen is arguably annoying enough to be considered a punishment or penalty. Nothing in claim 4 goes to greater specifics as to the punishment.

23. Regarding claim 19 -

Christiano discloses the system according to claim 18, wherein said validation device permits said user to execute said software application with said punishment if a previously valid authorization of said user is recognized (e.g. col 22, ln 5-20). Although Christiano does not use the term "punishment" the cited lines refer to ways in which the

software behaves differently while operating under the failsafe mode. Even if not termed “punishment” by Christiano, having a “failsafe” or “overdraft” message flashing constantly on the screen is arguably annoying enough to be considered a punishment or penalty. Nothing in claim 4 goes to greater specifics as to the punishment.

24. Regarding claim 20 -

Christiano discloses the system according to claim 19, wherein said license management system is a license server (e.g. fig. 1).

25. Regarding claim 21 -

Christiano discloses the system according to claim 19, wherein said punishment comprises at least one of a time delay, a time limit, a software impediment, and a disablement of functionality of said software (e.g. col 22 ln 5-20). As above, Christiano does not use the term punishment, however, he does describe messages being displayed when software is in use under failsafe status, which can be considered a software impediment.

26. Regarding claim 22 -

Christiano discloses the system according to claim 21, wherein said punishment increases if said user previously attempted access with said inaccessible license management system (e.g. col 22 ln 5-20). Although Christiano does not specify increasing a punishment it does discuss different ways to indicate failsafe and/or overdraft status. It would be obvious to one of ordinary skill in the art to include an increase in such ways to indicate failsafe or overdraft status as one more different ways of indicating said status.

27. Regarding claim 23 -

Christiano discloses the system according to claim 22, wherein said punishment decreases if said user subsequently is validly authorized using said license management system. Although Christiano does not specify increasing a punishment it does discuss different ways to indicate failsafe and/or overdraft status. It would be obvious to one of ordinary skill in the art to include a decrease in such ways to indicate failsafe or overdraft status depending on circumstances as one more different ways of indicating said status.

28. Regarding claim 24 -

Christiano discloses a computer program product embodied on a computer readable medium, said computer program product comprising program logic comprising program code means for enabling the computer to permit recognized users to execute said software application in the event of inaccessibility of said license management system (e.g. col 3 ln 67 – col 4 ln 4).

29. As above, Christiano does not specify exactly the same license descriptions and terms as in the instant claims, however, it would be obvious to one of ordinary skill in the art to adapt the teachings of Christiano in order to obtain the instant claims, thereby maximizing efficiency and accessibility in the use of mission-critical software

30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
32. Coley et al (US 5,790,664) disclose an automated system for management of licensed software.
33. Moskowitz et al (US 5,745,569) disclose a method for stega-cipher protection of computer code.
34. Battat et al (US 2003/0033402) disclose a method and apparatus for intuitively administering networked computer systems.
25. Misra et al (US 6,189,146) disclose a system and method for software licensing.
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.
27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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